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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/442,152	11/16/1999	TOSHIHIRO SHIMA	04783.010001	5476
22511	7590	04/27/2004	EXAMINER	
OSHA & MAY L.L.P. 1221 MCKINNEY STREET HOUSTON, TX 77010			WALLERSON, MARK E	
			ART UNIT	PAPER NUMBER
			2626	

DATE MAILED: 04/27/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/442,152

Applicant(s)

SHIMA, TOSHIHIRO

Examiner

Mark E. Wallerson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-5 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-5 and 10-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on 4/2/2004.
2. This application has been reconsidered. Claims 1-5 and 10-12 are pending.

Response to Amendment

3. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5 and 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 1 recites the limitation "the response" in lines 4 and 5 of the claim. There is insufficient antecedent basis for this limitation in the claim.
7. Claim 1 recites the limitation "the second response" in line 10 of the claim. There is insufficient antecedent basis for this limitation in the claim.
8. Claim 10 recites the limitation "the response " in line 6 of the claim. There is insufficient antecedent basis for this limitation in the claim.

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9. Claim 10 recites the limitation "the second response" in line 12 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Objections

10. Claim 12 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 12 depends on cancelled claim 8. It is also in improper form since it is a method claim, while claims 1 and 10 are apparatus and program claims respectively.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

12. Claims 1, 2, 3, 10, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee (U.S. 6,628,413).

With respect to claims 1 and 10, Lee discloses a printer (100 or 110) comprising means which directly makes a first request for obtaining a resource from a server (column 4, lines 44-55 and column 5, lines 18-26); means for determining the structure of the resource based on a response from the server (which reads on characteristics of a job) (column 5, lines 29-34 and column 6, lines 1-21 and column 6, lines 22-30); setting pages to be printed based on the structure of the resource (performing pagination) (column 6, lines 43-52); obtaining structural data within the pages to be printed (column 6, line 54 to column 7, line 11); generating print data and printing based on the generated print data (column 7, lines 34-49), wherein the request means, structural means, setting means, means for generating print data and the printing means are located on the printer (column 3, lines 52-61).

With respect to claims 2 and 3, Lee discloses means for judging the data format (characteristics) of the structural data and making a second request in accordance with the judging (column 6, lines 22-30).

With regard to claim 13, Lee discloses determining the layout of the resource based on information relating to size and position of data (column 6, line 43 to column 7, line 28).

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 4, 5, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Huttenlocher (U. S. 6,011,905).

With regard to claims 4, 5, 11, and 12, Lee does not clearly disclose that the data format is moving picture data and the second request means obtains the structural data with the offset value from the top position of the resource. Huttenlocher discloses that HTML provides more flexibility than ASCII, in that it supports embedded graphics, images, audio and video recordings and hypertext linking capabilities (column 2, lines 2-5). Huttenlocher also discloses a structural document with an imaginary nonempty strip just above the top of the image which is used to compute the offset value (column 23, line 64 to column 24, line 7), therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Lee by the teaching of Huttenlocher in order to obtain a resource from the server and discriminate different formats and means for generating print data to be printed, wherein the resource is written in HTML (figure 10).

Response to Arguments

15. Applicant's arguments with respect to claims 1-5 and 10-13 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (703) 305-8581. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the ~~Private~~ PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark E. Wallerson
Primary Examiner
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